

REMARKS

This amendment is submitted in response to the Office Action dated September 14, 2004, in which the Examiner objected to the specification and rejected all of the claims on statutory grounds. Specifically, claims 1-14 were rejected under 35 U.S.C. §§102 and 103 based upon prior art, the Examiner contending that some of the claims are unpatentable as anticipated by either Jenlis or Chang, and that other claims are unpatentable as obvious, either over Chang in view of Jenlis, or over Chang in view of Yang. Claims 1-14 were also rejected under 35 U.S.C. §112, second paragraph, the Examiner contending that various claims or groups of claims are indefinite for lack of antecedent basis. The objection to the specification related to its failure to provide support for the certain recitations in claims 2 and 11.

Regarding the objection to the specification, this objection has become moot in view of applicant's cancellation hereinabove of claims 2 and 11. For the same reason, the rejection of claims 2 and 11 under 35 U.S.C. §103 as unpatentable over Chang in view of Jenlis is also now moot, and should be withdrawn.

Turning now to the remaining substantive portions of the Office Action, applicant respectfully traverses those statutory grounds for rejection, since applicant earnestly believes that the claims, as amended hereinabove, are neither anticipated nor rendered obvious by the combination of prior art references upon which the Examiner relies, and

that they recite patentable subject matter in a fashion which is not indefinite and which is distinguishable over the cited prior art.

With regard to the claim rejections under 35 U.S.C. §112, second paragraph, for several instances of lack of proper antecedent basis, the amendments made by applicant hereinabove have in each instance either provided the necessary antecedent basis or have rendered the rejection moot. In particular, claim 1 has been amended to recite that the “at least one side wheel” has a “circumferential surface,” a “diameter” and an “outside diameter”; claims 3-5 have been amended to recite that the sparking wheel has an “outside diameter”; claim 6 has been amended to change “**the** lever” to “**a** lever”; and claims 10 and 14 have been cancelled.

Regarding the claim rejections based on prior art, claims 2, 9 and 11-14 have also been cancelled, and several features have been introduced into claim 1 (the only independent claim remaining in this application) in order to distinguish it from the prior art. First, the only limitation recited in cancelled claim 9, that the at least one side wheel is rigidly connected to the sparking wheel, has now been incorporated into claim 1. Second, claim 1 now specifies that no protrusion or indentation formed on the surface of the at least one side wheel exceeds 0.1mm in depth -- support for this limitation may be found in the specification, in the first paragraph on page 4. Finally, claim 1 now specifies that the at least one side wheel further comprises axles projecting from either side thereof, one axle being received in a bearing and the other being received in a

bearing in the sparking wheel -- support for this limitation may also be found in the specification, in the fourth paragraph on page 4.

Applicant contends that claim 1, as amended, is not anticipated by Jenlis. Claim 1 now specifies that any projections or indentations formed on the surface of the side wheel do not exceed 0.1 mm in depth. According to the disclosure of Jenlis, even in the embodiment shown, for example, in Figure 9, where there is a ring 5 which is smooth, the rest of the side wheel (referred to as a driver 3) clearly has a roughened surface. This roughened surface will, in the normal fashion, have indentations which are greater than 0.1 mm in depth.

According to the Jenlis disclosure, for example, column 2, lines 57 to 61 and lines 63 to 65, it is a feature of Jenlis that operation of the drivers can be obtained by an adult's finger or thumb, because of the size of the adult's finger or thumb. It is possible for portions of the adult's finger or thumb to extend past the smooth ring part 5 and contact the roughened outer surface 3 of the driver.

Thus, it is not the function of the smooth ring part 5 to induce the user's finger or thumb to slip, but to space a child's finger or thumb away from rough parts of the side wheel which the child could otherwise operate.

In contrast, in the present invention the side wheel has a smooth surface so that,

if a user applies the normal force, there is tendency for the user's finger or thumb to slip. Instead of trying to prevent access to operating the parts of the sparking wheel, as in Jenlis, the side wheel allows access to the drive surfaces of the sparking wheel but makes it much more likely that the user's finger or thumb will slip on these drive surfaces. This method of operation is not disclosed in Jenlis, and accordingly, as currently amended, claim 1 is not anticipated by Jenlis.

By providing relatively smooth side wheels which induce a user's finger or thumb to slip, it is not only possible to prevent operation by children but also accidental operation or operation by an adult who is not taking adequate care. This additional safety feature is not mentioned in Jenlis. It is also noted that, in Jenlis, there are embodiments in which the ring 5 is a separate structure which is not fixed to the side wheel. This does not itself comprise a side wheel as required by claim 1, because it is not connected with the sparking wheel nor is it mounted by bearings in the side wheel and other structures of the lighter.

Applicant contends that claim 1, as amended, is also not anticipated by Chang. Chang discloses two embodiments. The first, which is described in Figures 2-4 comprises a sparking wheel 52 in which a roughened, sparking surface 52 is formed in a central portion, the side portions comprising circular discs 53 and 54 which are left smooth. Chang discloses that these circular discs are provided to afford a better striking contact (column 5, line 23-29). It is also specified that the circular discs can be

integral with the striking wheel (column 5, line 31-32) or made by fixing discs onto the sides of the striking wheel (column 5, line 34-35).

Chang does not disclose, however, that the side wheels themselves may comprise axles which engage on one side in a bearing, and on the other side in a bearing in the sparking wheel. Rather, in Chang the axle is understood to be *integral* with the sparking wheel.

Accordingly, claim 1 as amended is distinguishable over Chang in that the side wheel is a separate body which is fixed to the sparking wheel. This construction affords an advantage in that conventional sparking wheels can be used, rather than specially designed ones. Further, manufacture is simplified.

Moreover, in the case in Chang where the side wheels comprise discs which are attached adjacent the sparking wheel, the side wheels are presumably mounted on relatively long axles which have to extend through the discs to the bearings formed in the bracket. Such axles are relatively difficult to form and are weak in use. The structure claimed in claim 1 overcomes these problems.

Furthermore, it appears to be contemplated in Chang that the side wheel portions 53 and 54 are to make it easier to operate the device, rather than harder. This is what is understood by the reference to the side wheels providing "a better striking contact

with an adult thumb by increasing the contact area..." (column 5, line 25). This contrasts with the role of the side wheels in the present invention, in which side wheels are included so as to induce a user's thumb or finger to slip. This slipping effect is not mentioned at all in Chang.

Thus, independent claim 1, as amended, is not anticipated, either by Chang or by Jenlis, and accordingly, dependent claims 3-8, 15 or 16 (which incorporate all of the limitations of amended claim 1) can neither be anticipated nor rendered obvious by those references either, whether they are each taken alone or in combination. Thus, claim the rejections under 35 U.S.C. §102 have been overcome, and since in the remaining claim rejections under 35 U.S.C. §103 the Examiner placed principal reliance on Chang, those rejections must fail as well.

Nevertheless, the dependent claims of the present invention provide further distinctions from the prior art. First, referring to claim 5, it is preferred that the diameter of the side wheel be smaller than the outside diameter of the sparking wheel, as the moment or leverage of the force exerted by user's thumb on the side wheel will be smaller, increasing the tendency to slip rather than rotate the wheel (see the first paragraph on page 5 of the specification).

Regarding claim 6, it is submitted that neither of the references cited by the examiner discloses resilient means being provided between the free end of the lever

and the bracket on which the lever is mounted. This resilient means is of course separate from the resilient means engaging the flint. By providing a further spring between the lever and the bracket, an additional safety feature is introduced. In particular, force required to operate the lever is increased, making it harder for children to operate the lighter and making accidental operation of the lighter harder. There is no disclosure in any of the prior art of this additional feature.

For all of the foregoing reasons, all of the rejections based upon prior art should be withdrawn.

The Commissioner is requested to construe this paper as including a retroactive petition for a two-month extension of time in which to file a response to the outstanding Office Action, and accordingly, a check for the official fee of \$450.00, prescribed therefor by 35 U.S.C. §41(a)(8), as amended, in the case of a non-small entity, is submitted herewith. The Commissioner is authorized to charge any additional extension fees which may be required, or to credit any overpayment, to Deposit Account No. 07-1730.

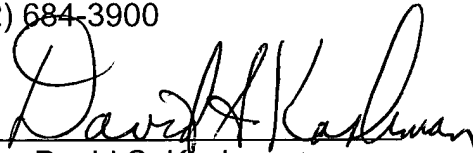
Applicant has responded herein to each of the points raised by the Examiner in the Office Action, and applicant has explained why applicant believes that all of the pending claims, as amended, are not indefinite and are patentable over the cited prior art. Accordingly, further favorable action in connection with this patent application is

earnestly solicited. The Examiner is invited to contact the undersigned attorney by telephone if it will advance the prosecution of this case.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on:

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